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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/574,386	05/19/2000	Donna G. Albertson	M-9144 US	7843

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EXAMINER

SPIEGLER, ALEXANDER H

ART UNIT PAPER NUMBER

1637

DATE MAILED: 11/27/2002

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Please find below and/or attached an Office communication concerning this application or proceeding.

**Advisory Action**

Application No.

09/574,386

Applicant(s)

ALBERTSON ET AL.

Examiner

Alexander H. Spiegler

Art Unit

1637

--Th MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 03 July 2002 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

**PERIOD FOR REPLY** [check either a) or b)]

- a) ☐ The period for reply expires \_\_\_\_\_ months from the mailing date of the final rejection.
- b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection. ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☒ A Notice of Appeal was filed on 2/20/02. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☒ The proposed amendment(s) will not be entered because:
- (a) ☒ they raise new issues that would require further consideration and/or search (see NOTE below);
  - (b) ☐ they raise the issue of new matter (see Note below);
  - (c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
  - (d) ☒ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: See Continuation Sheet.

3. ☐ Applicant's reply has overcome the following rejection(s): \_\_\_\_\_.
4. ☐ Newly proposed or amended claim(s) \_\_\_\_\_ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☒ The a) ☐ affidavit, b) ☐ exhibit, or c) ☒ request for reconsideration has been considered but does NOT place the application in condition for allowance because: See Continuation Sheet.
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☒ For purposes of Appeal, the proposed amendment(s) a) ☒ will not be entered or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: \_\_\_\_\_.

Claim(s) objected to: \_\_\_\_\_.

Claim(s) rejected: 1-22.

Claim(s) withdrawn from consideration: \_\_\_\_\_.

8. ☐ The proposed drawing correction filed on \_\_\_\_\_ is a) ☐ approved or b) ☐ disapproved by the Examiner.
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). \_\_\_\_\_.
10. ☐ Other: \_\_\_\_\_

Continuation of 2. NOTE:

a) The proposed amendment of Claim 1 recites, "using sequences within adapters to amplify the modified polynucleotide". The previous claims did not require this limitation, and therefore, the proposed amendment would bring up new issues under 112, 2nd paragraph. Additionally, the proposed amendment of Claim 6 adds the recitation of "cosmid" clones, which was not required in the previous claims and would therefore, raise new issues that requiring further search and consideration.

d) Applicants cancel claims 2 and 22, but add new claims 23, 24 and 25.

Continuation of 5. does NOT place the application in condition for allowance because of the reasons of record, and in view of the non-entry of the amendment filed on 7/03/02.

Further considerations:

112, 2nd paragraph: Applicants can overcome the rejections of "the corresponding first polynucleotide" if Applicants file a separate amendment addressing only this rejection. However, since the amendment of 7/3/02 is not entered, the rejection has not been overcome

102 rejection: is maintained in view of the non-entry of Applicants amendments of 7/3/02.

103 Rejections: are maintained in view of the non-entry of Applicants amendments of 7/3/03. Additionally, it is noted that Applicants argue limitations not found in the claims, such as "these method steps amplify essentially all of the polynucleotide sequences in the mixture" and "to amplify the polynucleotide in the mixture to essentially the same extent", "to produce an amplification product that is representative of the entire starting polynucleotide" (pgs. 8-9 of Applicants After-final paper).

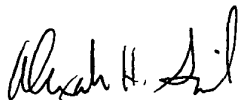
Declaration of Dr. Donna G. Albertson (submitted on August 3, 2002): has been considered, but is not persuasive to overcome the rejections. The declaration provides a detailed description of Example 1 of the instant invention, in order to exemplify the differences between the claimed invention and the prior art of Smith et al. Furthermore, the declaration seeks to demonstrate that the claimed method requires the production of a target solution that is representative of essentially an entire starting material. This declaration is not persuasive because the method steps exemplified in the declaration are not the method steps of the claimed invention, and at best, represent only a specific embodiment of the claimed invention. The patentability of the claims are based on actual method steps of the claims, not additional, more specific method steps that appear in an example of the specification. While Dr. Alberston's declaration is helpful in understanding the claimed invention, it is not sufficient to overcome the claim rejections.

#### Correspondence


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Alexander H. Spiegler whose telephone number is (703) 305-0806. The examiner can normally be reached on Monday through Friday, 7:00 AM to 3:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gary Benzion can be reached on (703) 308-1119. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 308-4242 and (703) 305-3014. Applicant is also invited to contact the TC 1600 Customer Service Hotline at (703) 308-0198.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0196.



Alexander H. Spiegler  
November 25, 2002



KENNETH R. HORLICK, PH.D  
PRIMARY EXAMINER

11/26/02